

REMARKS

I. Introduction/Amendment

Claims 1-36 and 41 are presently pending, and claims 37-40 were previously withdrawn from consideration.

Previously, each of independent Claims 1, 17, and 27 was amended to reflect that the dead bank card is a dead deposit card for an inactive deposit account “comprising a checking account or a savings account.” Applicant regarded this as already being inherent in the claims, as the dead bank card was previously recited as being “associated with an inactive deposit account.” Applicant regards “dead deposit cards” as recited in the amended claims as encompassing (dead) debit cards, check cards, and ATM cards, but not credit cards or charge cards.

With this submission, each of independent Claims 1, 17, and 27 is amended to reflect that “the dead deposit card and inactive deposit account [are] unsolicited” and the dead bank card is delivered with embossed information and magnetic stripe information that is “specific to the person”. Applicant regards that amendment as a matter of clarification as those features were already inherent in the claims.

II. Rejections Under 35 U.S.C. § 103

A. Claims 1-22, 24-26, and 41 Are Patentable Over the Six-Part Combination of Melchione + Walker + Richards + Bankersonline.com + Jones + Nabe

Claims 1-22, 24-26, and 41 stand rejected under 35 U.S.C. § 103 as rendered obvious by the 6-part combination of:

- (1) Melchione (US Pat. No. 5,930,764) in view of
- (2) Walker (US Pub. No. 2008/0052225), further in view of
- (3) Richards, B., "Beware the Arrival of Unsolicited Debit Cards (Madison Capital Times: 2000), further in view of
- (4) Bankersonline.com, Commentary; Supplement I to Part 205 - Official Staff Interpretations: Jan 31,2002, www.bankersonline.com/regs/205/regecomm.txt at pages 1-35, further in view of
- (5) Jones (US Pub. No. 2004/0117300), and further in view of
- (6) Nabe (US Patent No. 7,305,364).

Office Action at 2-3. Applicant respectfully submits that the combination of these six references does not render the claimed invention obvious. Applicant shall first analyze the combination with regards to Claim 1.

1. "Identifying . . . a pool of potential new bank deposit account holders for a bank [and] determining . . . if a person from the pool is an existing bank deposit account holder"

According to Claim 1, dead bank cards may be distributed in an unsolicited manner based on "identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder."

Melchione

The primary reference, Melchione, describes a sales lead generation system for marketing campaigns that is based on a central database with information on all bank customers called the CCIS (Central Customer Information System). Melchione, Abstract; Figure 1; Summary, Col. 5-7 (e.g., “the central database serves as a single repository for storing all customer related information throughout the business”; “central database . . . is a comprehensive and enriched database that includes information about all customers and products in the financial institution”). Using the central customer database, sales leads are generated and then administered (marketed) through dedicated stations called micro-marketing centers. Melchione, Abstract; Figure 1.

Melchione does not teach or suggest “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.” At best, Melchione teaches a generalized system of marketing based on customer information in a database. **Nowhere does Melchione disclose (1) creating a pool of potential new deposit account holders and then (2) determining if a person from the pool is an existing bank deposit account holder.** For example, Figure 5 of Melchione shows a flowchart for generating lists of leads based on the central customer database. Figure 5 does not teach or suggest generating a pool of potential bank deposit account holders and then determining if a person from the pool is an existing bank deposit account holder.

At page 3 of the Office Action, the Examiner cites to Melchione at Figure 1; Col. 1, lines 1-29; and Col. 27, lines 32-43, 41-48 as disclosing this claim limitation. However, Figure 1 merely “is a high level view of the sales and service support system of the present invention”. Figure 1 does not remotely disclose the claim limitation at issue. Column 1, lines 1-29 of Melchione sets forth the Field of the Invention:

“The present invention relates generally to a sales and service support system and method, and in particular, to an electronic sales and service support system and method for assisting customer service and identifying sales targets, distributing sales leads, enhancing sales tools, and tracking performance of sales and sales personnel.”

That passage does not remotely disclose the claim limitation of “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

Another passage cited by the Examiner (see Office Action at 3) describes a generic, searchable database of customer information for generating leads based on search profiles:

“A plurality of micromarketing workstations 12 preferably make up the micro marketing center 11 for responding to requests from branch managers for lists of leads for selected sales programs. The sales programs typically involve a marketing campaign for new or existing products or services offered by the financial institution. **The micro marketing center 11 works with the branch managers to determine the profile of households, customers, and/or accounts most likely to purchase the products or services of the sales campaign. The micro marketing center then constructs a specific query, runs the query against the central database, and generates a report containing an optimum list of leads for each marketing campaign.** The workstation at the micro marketing center provides means for searching the central database 10 and extracting a list of all households, customers, or accounts that meet a specific selection criteria. The list of leads are then used to target a direct mailing to the customers or households that meet the specific selection criteria for the sales campaign, or the list of leads is sent directly to the CCIS 13.”

Melchione, Col. 27, lines 29-48 [emphasis added]. That passage does not remotely disclose the claim limitation of “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

The Examiner also references Figure 13A in connection with this claim limitation. Office Action at 3. According to Melchione, Figures 13A-M “are a flow chart showing the preferred process for performing the step of building an account in the method.” Thus, these figures are directed to building various new accounts, not identifying a pool of potential new

bank deposit account holders and determining if a person is an existing bank deposit account holder, as claimed. In the recent Office Action, the Examiner adds to the description of Figure 13A that “the workstation at the Micro-marketing center provides means for searching the central database and extracts accounts that meet[] specific selection criteria.” Office Action at 3. As noted above, Applicant agrees that Melchione teaches that general functionality. The relevant issue, however, is that Melchione does not teach or remotely suggest “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

The Examiner also references Figures 10A and 10B and Col. 44, lines 10-14. Column 44, lines 10-14 simply describe these figures as showing the “account opening process” for a new customer (Fig. 10A) and for an existing customer (Fig. 10B). They say nothing remotely about “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

Other References

The other references relied on by the Office Action do not teach or suggest this claim limitation. Walker teaches the offer of a preapproved unsolicited credit card by a sponsoring organization (e.g., casino) based on the expected arrival time of a consumer at the sponsor’s location (checking in at the casino). Walker, Abstract; Figs. 5A-5C. Richards discloses a consumer advocate’s complaint about an unsolicited debit card being improperly sent for an existing, active deposit account. Bankersonline.com provides some staff interpretations by the Federal Reserve regarding 12 C.F.R. § 205 (Regulation E) which governs Electronic Funds Transfers (EFTs). Jones teaches a solicited dual card having a private label credit card (PLCC) account for the merchant and a general-use bank credit card account. Jones, Abstract; Fig. 2B.

Nabe teaches a customer lead generating system for dealers selling products like replacement auto loans. Nabe, Abstract; Fig. 3.

None of the above references teaches or suggests “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

2. **“Unsolicited dead bank card . . . a dead deposit card associated with an inactive deposit account comprising a checking account or a savings account”**

According to Claim 1, the issuing bank will distribute an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.”

Melchione

In the latest Office Action, the Office Action admits that the primary reference Melchione fails to teach distributing (a) a **dead bank card** [dead deposit card], that is (b) **unsolicited by the recipient**, and that is (c) **associated with an unsolicited, inactive deposit account**. See Office Action at 4 (Melchione “do[es] not teach creating an unsolicited dead bank card comprising a dead deposit card”); at 4 (Melchione “do[es] not teach a dead bank card associated with an inactive bank account, and distributing the dead bank from the issuing bank to the person”); at 5 (Melchione “do[es] not teach issuing [a] dead bank card associated with [a] deposit account”); at 9 (Melchione “do[es] not teach distributing an unsolicited dead bank card associated with an inactive bank account to the customer . . .”).

Because Melchione fails to teach these three separate claim elements, the Examiner turns to five other references (Walker, Richard, Banklonline.com, Jones, and Nabe) to address the deficiencies of the primary reference.

Other References: Walker

Starting with Walker, the Office Action asserts that Walker teaches distribution of a dead bank card that is unsolicited and associated with an inactive account. Office Action at 4-5, 9 (Walker teaches “distributing an unsolicited dead bank card associated with an inactive bank account”). Actually, Walker teaches the offer of a preapproved unsolicited credit card by a sponsoring organization (e.g., casino) based on the expected arrival time of a consumer at the sponsor’s location (checking in at the casino). Walker, Abstract; Figs. 5A-5C. Walker, considered alone or in combination with Melchione, does not teach or suggest, creating unsolicited dead deposit bank cards associated with an inactive deposit account and distributing those dead deposit bank cards. Rather, Walker teaches in-person distribution of unsolicited credit cards associated with a credit card account.

In attempting to read Claim 1 on Walker, the Examiner disregards the limitation of Claim 1 that the claimed subject matter is directed to “dead bank cards”/“dead deposit cards” and “inactive deposit accounts comprising a checking account or savings account.” A credit card account is not a deposit account, is not a checking account or savings account, and they are not treated the same in the financial services industry. To emphasize the distinction, Applicant previously amended the claim to provide that the claimed dead bank card is a “deposit account card” (e.g., a debit card) and that the inactive deposit account is a “checking account or savings account”, which obviously does not encompass the credit card account of Walker.

Ironically, the Richards reference emphasizes that credit cards and deposit cards like debit cards are treated very differently in the banking industry. In complaining about an unsolicited debit card he received, consumer advocate Bob Richards noted:

“Unlike a credit card, a debit or check card allows you to instantly withdraw money from a checking or savings account. We now were wondering, of course, what might have happened had we simply thrown the envelope with the debit card in the trash without first bothering to cut it up. . . . The infuriating part of this is that it forces us as consumers . . . to shred or otherwise destroy it [debit card], in order to prevent a thief from emptying our check or savings account.”

Richards, full text, page 1. Therefore, Richards confirms that credit cards and debit cards are not interchangeable, and thus, Walker’s unsolicited credit card does not teach or fairly suggest distribution of unsolicited deposit account cards.

Other References: Richards

The Examiner tries to make up the deficiencies of Melchione and Walker by citing the Richards as teaching the issuance to customers of preapproved unsolicited debit cards which need to be accepted and activated. Office Action at 10. The Richards article discloses a consumer advocate’s complaint about an unsolicited debit card being improperly sent for an existing, active deposit account. Richards is very distinguishable from the claimed “unsolicited dead bank card . . . [that is] a dead deposit card associated with an [unsolicited] inactive deposit account”.

First, contrary to the Examiner’s assertion, the unsolicited debit card of Richards was already active on arrival:

“[W]ithout following the activation procedure, we went to a grocery store automated teller machine (ATM), swiped the card and entered the PIN number. That was all that was required to obtain a ‘quick’ \$20. The printed receipt also disclosed the remaining balance in that [preexisting] account. . . . Several days later, my wife made a department store purchase and offered the card as payment . . . The clerk swiped my card through the machine, the receipt was printed, she signed it, and the transaction was accepted . . .”

Richards, full text, page 1. Thus, Richards does not teach an inactive, dead deposit card. On the contrary, Richard's deposit card (debit card) was active—that was one reason for his alarm and complaint.

Second, contrary to the Examiner's assertion, the unsolicited debit card of Richards was not associated with an inactive deposit account, as claimed. On the contrary, the debit card in Richards was associated with a preexisting active deposit account. This was another reason for Mr. Richard's alarm:

“[W]ithout following the activation procedure, we went to a grocery store automated teller machine (ATM), swiped the card and entered the PIN number. That was all that was required to obtain a ‘quick’ \$20. **The printed receipt also disclosed the remaining balance in that account.** . . .

Richards, full text, page 1. Thus, Richards does not teach distribution of a card associated with an inactive deposit account. On the contrary, Richard's deposit card (debit card) was associated with his active deposit account at the time the card was received.

Finally, Richards actually teaches away from the claimed feature of distribution of an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.” First, Richards' article is generally a siren call against the distribution of unsolicited debit cards. Richards (“Beware the Arrival ...). Second, the issuing bank M&I stated that the unsolicited bank card **had been sent in “error”**, and that the **problem had “been corrected”** so that it would not happen again. Richards, full text, page 1. Thus, while Richards disclosed an incident of an unsolicited debit card being sent, it was done in error and was criticized as improper by both the card recipient and the issuing bank. Under those facts, Richards plainly teaches away from the claimed feature. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007). See also M.P.E.P. § 2141.02(I)(6) (“A prior

art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). A disclosure teaches away where it criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). That is precisely what Richards does.

Other References: Bankersonline.com

In the recent Office Action, the Examiner cites to Bankersonline.com, page 9, § 5(b) (Unsolicited Issuance) in an effort to cure the deficiencies of Richards and the other four references relied upon in this 6-part obviousness rejection. Bankersonline.com provides for unsolicited issuance of an account “access device” such as a debit card (see page 1, § 2(a)(1) of the reference) as follows: “A financial institution may issue an unsolicited access device (such as the combination of a debit card and PIN) if the institution's ATM system has been programmed not to accept the access device until after the consumer requests and the institution validates the device.”

As best as Applicant can discern, that statement means that a bank can send a new debit card to replace a debit card that has expired—for an existing, active bank account. It is standard practice for banks to send out replacement debit cards to replace debit cards whose expiration dates are near. This provision of Regulation E appears to permit that practice.

This provision does not describe sending a dead bank card [dead deposit card] **associated with an inactive deposit account**. Additionally, this provision does not describe sending a dead bank card associated with an **inactive deposit account that, like the dead bank card, is unsolicited**, as recited in the amended claim. Furthermore, even though the claimed card is

associated with an inactive account, the “dead bank card include[es] embossed information and magnetic stripe information” that is “specific to the recipient”, as in the amended claim. This vague passage in Bankersonline.com falls well short of disclosing or suggesting a bank issuing a completely unsolicited bank card that is already marked with personal information on the card (e.g., the person’s name is embossed and written to the mag stripe) for an unsolicited and inactive deposit account.

Other References: Jones

The Examiner cites Jones as teaching a dead debit card to cure the deficiencies of Melchione, Walker, Richards, and Bankersonline.com. Jones teaches a solicited “dual card” having a private label credit card (PLCC) account for the “homebrand” merchant and a general-use bank credit card account for other merchants. Jones, Abstract; Fig. 2B; par. [0027] (“The dual card includes features of both a private label card and a credit card”). The dual card allows purchase transactions to be run on either (1) the closed-loop processing network (private label network) when shopping at the homebrand merchant, thus saving the merchant transaction fees, or (2) when shopping at other merchants, the purchase transactions can be run on the open-loop processing network (interchange like VISA or MasterCard). Jones at par. [0022]. As with Melchione, the system in Jones must receive permission from a consumer before sending the card—i.e., **the dual card is not unsolicited, rather, it is requested**. See, e.g., Jones at par. [0027] (“[A] dual card is issued to a consumer upon receipt of an application . . .”) Thus, Jones fails to cure the deficiencies of the other references by failing to teach unsolicited distribution of a dead bank deposit card associated with an unsolicited bank account.

The Examiner cites to Jones at pars. [0023], [0050], [0055], and [0059]. Office Action at 5, 11. None of these passages teaches or suggests the claim feature at issue of distributing an

“unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account” that also is unsolicited. Par. [0023] of Jones simply defines “bankcard” as referring to “credit, debit, or charge card.” Par. [0050] describes that a dual card can be presented at a non-homebrand merchant and run over the interchange network for approval. Par. [0059] describes how a PLCC private label accountholder may be upgraded to a dual card “if the consumer has accepted the invitation (or, has failed to opt out within the opt out period)”. None of these passages teaches the unsolicited dead deposit card of the present invention associated with an unsolicited bank account, and the last passage (par. [0059]) teaches away by emphasizing that the dual card is not unsolicited—instead, it is requested.

Other References: Nabe

The Examiner cites to Nabe in order to compensate for the deficiencies of the other five references. Specifically, the Examiner cites Nabe as teaching selling to an “inactive customer base”. Office Action at 5, 11. Nabe is generally directed to a customer lead generating system for dealers selling products like replacement auto loans or new loans for new car purchases. Nabe, Abstract; Fig. 3. Nabe uses a database of Inactive Auto Finance Customers to find possible leads for a loan for a new car or a refinanced loan for an existing vehicle. Nabe, Fig. 4; par. [0028], par. [0037]. Using various marketing models (e.g., direct response model), Nabe selects a subset of former customers likely to need a loan. Thus, Nabe is only directed to loan accounts, not deposit accounts, and Nabe does not teach or suggest distribution of dead cards (or any other cards) of any type. In the final analysis, Nabe does not remotely teach or suggest distributing an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.” Thus, the

Examiner does not seem to be considering the claimed invention as a whole but rather appears to be treating the claim as merely a laundry list of limitations. *See* M.P.E.P. § 2141.02(I).

3. “Distributing the dead bank card from the issuing bank to the person”

The independent reflect that the dead bank card is distributed “from the issuing bank to the person/recipient”. As discussed above in Section III.A.2, Walker at best teaches the delivery of unsolicited credit cards to consumers, not unsolicited dead bank cards (dead deposit cards). A further distinction is that Walker does not disclose distributing those cards from the issuing bank to the consumer. Instead, Walker teaches that the sponsoring organization (casino) must distribute the card in person to the recipient. Walker, Fig. 5A (“Upon Arrival, Offer Credit Card to Customer”); par. [0017] (“initiating an offer of the credit card to the customer while the customer while the customer is at the remote location); par. [0032] (“a plastic credit card is shipped to the hotel, and the hotel offers the card to the customer upon check-in, or otherwise during the customer’s stay at the hotel”). Walker takes the approach of having the sponsoring organization—not the issuing bank—distribute the cards to the customer because of Walker’s focus on reducing the number of credit cards sent by banks to consumers that are never activated. Walker, par. [0008] (“A significant portion of newly issued cards never get activated”). Thus, Walker not only fails to teach distribution by the issuing bank to the recipient, as claimed, but it teaches away.

4. Independent Claim 17 and Dependent Claims 2-16, 18-22, 24-26 and 41 Are Patentable for the same reasons as Claim 1

Independent Claim 17 recites similar features to those of Claim 1 that distinguish it from the asserted art in Sections III.A.2 and III.A.3 above. Accordingly, Applicant requests that the

Examiner withdraw the rejection of Claim 17, as well as dependent Claims 2-16, 18-22, 24-26, and 41, each of which depends directly or indirectly from either Claim 1 or Claim 17.

5. Dependent Claims 2 and 19 Are Separately Patentable over the Six-Part Combination

Dependent Claim 2 provides that “the pool [of potential new bank account holders] is identified based on the region or regions served by the bank issuing the new bank accounts.” Dependent Claim 19 provides that whether a “customer is eligible comprises determining whether the customer resides within the bank account service footprint of the bank.” The Office Action concedes that “Melchione . . . doe[es] not teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts”. Office Action at 6.

The Office Action contends this missing feature is provided by Walker at par. [0032]. However, that passage merely states that “when a customer makes a reservation at a hotel, the hotel requests a credit card on the customer’s behalf. If the issuing bank approves a credit line, a plastic credit card is shipped to the hotel, and the hotel offers the card to the customer upon check-in.” That passage does not remotely teach creating a pool “based on the region or regions served by the bank issuing the new bank accounts”. If there is a pool in Walker, it is the pool of guests checking into the casino, not a pool for the region that the bank serves.

In the case of Claim 19, the Office Action asserts that Melchione discloses “determining whether the customer resides within the bank account service footprint of the bank” at Fig. 6C, Col. 35, lines 49-67 to Col. 36, lines 1-22. Office Action at 12. However, Figure 6C of Melchione merely shows a customer profile screen at a workstation. Melchione at Col. 35, lines 49-67 and Col. 36, lines 1-22 disclose a “household account summary screen” of Fig. 6C shows “accounts and other information for all members of a selected household . . . [as well as other]

information about the customer (e.g., homeowner, children, competitor, business address change, etc.).” It goes on to say that this screen may include “best guess” demographic information for use in planning calls or for developing sales plans.” Melchione, Col. 36, line 66-Col. 37, line 1. These passages do not remotely teach or suggest “determining whether the customer resides within the bank account service footprint of the bank”, as recited in Claim 19.

Applicant respectfully requests that the rejection of Claims 2 and 19 be withdrawn.

6. Dependent Claim 3 is Separately Patentable over the Six-Part Combination

Dependent Claim 3 provides that the “pool is identified based on individuals applying for a new credit account.” The Office Action asserts that Melchione teaches this feature at Fig 10B and Column 27, lines 39-48 and Col. 27, lines 28-58. Office Action at 6. However, Figure 10B is a flow diagram of a method for “opening an account with an existing customer in the integrated financial system.” Melchione at Col. 13, lines 30-34. Figure 10B is described as a generic “Account Opening System and Servicing Process” and it does not appear that the description of Figure 10B beginning at Col. 43, line 30 includes disclosure of a “pool [of potential new bank account holders] being identified based on individuals applying for a new credit account”, as claimed. In the last response, Applicant noted that the passage on Figure 10B is lengthy and jumps between various figures, so Applicant requested that the Examiner provide a pin-point cite to where the Examiner contends Melchione teaches Claim 3.

The additional citations provided by the Examiner in the latest Office Action and Column 27, lines 39-48 and Col. 27, lines 28-58 describe in general terms how marketing campaigns can be initiated by developing consumer profiles likely to be interested in a product and then

developing search queries to be run against Melchione's central database so as to develop leads. The passage does not reference anything related to the claim limitation of creating a pool where the "pool is identified based on individuals applying for a new credit account."

7. Dependent Claims 9 and 21 are Separately Patentable over the Six-Part Combination

Dependent Claim 9 provides for "determining whether the person was a previous bank account holder." Dependent Claim 21 has similar language. The Office Action contends this feature is taught by Melchione in Figure 10A and 10B. Office Action at 7. As previously noted, Figure 10A is the "account opening process" for a new customer and Figure 10B is that for an existing customer. Melchione, Column 44, lines 10-14. Neither figure describes "determining whether the person was a previous bank account holder." Applicant notes that Melchione's different customer service processes for new customers and existing customers is not the same as "determining whether the person was a previous bank account holder."

Figure 10A is described as a method for "opening an account with a new customer in the integrated financial system". Melchione, Col. 13, lines 26-30. The Review Profiles block is described as follows:

"REVIEW PROFILE SYSTEM AND STEP (200). Before meeting with the customer, the user (personal banker) should review the customer profile to prepare for the sales conversation. The system preferably includes a general purpose computer and/or networked work stations for this purpose. The computers or workstations should, of course, include some type of display. The principal objective of the profile review is to prepare for a sales session with the customer. Again, where legal and appropriate, additional information obtained from the central database, for example, could be used during this step."

Melchione, Col. 45, lines 20-31.

The "Needs Assessment" the Examiner refers to is described as follows:

“NEEDS ASSESSMENT SYSTEM AND STEP (500). The needs assessment step is essentially a sales tool to allow the user and customer to choose the best account and account components for the particular customer's needs. A system used for the Needs Assessment step is flexible such that data can be provided in an order that is consistent with the sales expertise of the user or telephone service center rep and the expressed needs of the customer.”

MelCol. 46, lines 28-39.

The passages the Examiner cites to (Col. 44, lines 10-21, 48-67 and Col. 45, lines 59-67), which relate to the different process flows for new and existing customers. For example, Col. 44, lines 10-21 states:

“The differences [between Figures 10A and 10B] reflect the fact that the bank already has basic information concerning existing customers and the fact that existing customers typically have some familiarity with the services and access devices offered by the bank. In a more general sense, the differences in the process steps reflect the difference between account creation and account conversion.”

Col. 44, lines 48-67 describes how different levels of information about a new or an existing customer can be made available to the teller/banker, while Col. 45, lines 59-67 describes the flexibility of the system in helping the customer who needs a short amount of time as well as a longer amount of time.

Applicant respectfully submits that none of these passages teaches or suggests “determining whether a person was a previous bank account holder”, as claimed.

8. Dependent Claims 10 and 22 are Separately Patentable over the Six-Part Combination

Dependent Claim 10 provides for “determining why the person closed the previous bank account in the event the person [from the pool of potential new bank account holders] was a previous bank account holder.” Dependent Claim 22 has similar language. The Office Action contends this feature is disclosed by Melchione in Figures 10A and 10B including steps 200-700,

and Col. 44, lines 10-26. Office Action at 7. Applicant has reviewed these cites and finds no support that they disclose the claimed feature. These passages simply describe general customer intake and handling procedures for new and existing customers. After citing to Figures 10A and 10B, the Office Action concludes that the “system distinguishes new customer and existing (or past) customer during the session and required information is received and processed accordingly”. That general statement does not suggest, much less disclose, the step of “determining why the person closed the previous bank account in the event the person [from the pool of potential new bank account holders] was a previous bank account holder.”

9. Dependent Claim 12 is Separately Patentable over the Six-Part Combination

Dependent Claim 12 provides “determining whether the person is eligible [for opening a new bank account] comprises determining whether the person is an existing or past credit card account holder with the bank and evaluating the payment history if the person is an existing or past credit account holder.” The Office Action contends this limitation is disclosed by Melchione at Col. 34, lines 20-40. See Office Action at 8.

That passage describes the “Relationship Profile” component of Melchione’s system that allows a CSR “to find and view household, customer, and account level information . . . [including] current and historical financial and behavioral information about the total relationship of the household or customer with the financial institution.” Melchione, Col. 34, lines 20-26. Applicant respectfully submits that such broad-brush statements do not disclose the specific claim limitation at issue here.

10. Dependent Claim 14 is Separately Patentable over the Six-Part Combination

Dependent Claim 14 provides for “prebuilding an account if the person is determined to be eligible [for opening a new bank account], thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person”. The Office Action contends this feature is disclosed in Figures 10A and 10B of Melchione, including Col. 49, lines 1-67 and Col. 50 1-67. Office Action at 8.

As previously noted, Figure 10A is the “account opening process” for a new customer and Figure 10B is that for an existing customer. Melchione, Column 44, lines 10-14. Neither discusses prebuilding an unsolicited account, in fact, both figures are very clear that any product that is sold is done as a result of interaction with the customer—i.e., any sale is solicited. Col. 49-50 is consistent with this interpretation, as it is noted that “the present invention provides a visual interface that allows the user **and customer** to watch the account as it is being built.” Melchione, Col. 50, lines 29-31. If the customer is watching, obviously there is no pre-building of an unsolicited account, as recited in the claims.

11. Dependent Claim 23 is Separately Patentable over the Six-Part Combination that adds Strock

Claim 23 provides for “a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers.”

The Examiner admits that Melchione does not disclose the additional limitation of Claim 23. See Office Action at 15. In order to close the gap, the Examiner adds Strock, U.S. Pub. No.

2004/0122736 to the now 7-part combination. The Office Action asserts that Strock teaches the limitation of Claim 23 at Figure 3B and par. [0002]. Strock generally discloses methods for granting promotional awards to credit card account holders if the customer accomplishes the promotional reward-earning behavior within the promotional time frame. Strock, Abstract.

Applicant cannot discern how Figure 3B of Strock discloses the limitation of Claim 23, and the Office Action does not explain how it might. Paragraph [0002] of Strock states the following:

[0002] The present invention is generally related to data processing techniques for enabling bank customers to earn promotional rewards. More particularly, the present invention is related to a data processing technique for allowing a Bank's existing credit cardmembers to earn promotional rewards for specific triggering behaviors in a specific time frame, wherein the rewards can be targeted to specific cardmembers or groups.

Applicant respectfully submits that the above passage of Strock does not teach or suggest “a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers”, as claimed.

12. Dependent Claim 24 is Separately Patentable over the Combination

Claim 24 provides that a “live credit card and dead bank card [dead deposit card] are communicated to the customer in a single mailing.” The Office Action asserts this feature is disclosed in Melchione at Figure 16A which is asserted to show “where the bank issues different credit cards (secured and unsecured), mailing of which can be together or separately.” Office Action at 13.

Applicant respectfully disagrees. The claim provides that a live credit card and dead deposit card are sent in a single mailing. That is quite different from sending a secured credit card and an unsecured credit card. Moreover, Figure 16A does not appear to even disclose sending a secured credit card and unsecured credit card together. If the Examiner believes that Melchione discloses the claimed feature of sending a “live credit card and dead bank card [dead deposit card] . . . in a single mailing”, a pin-point citation is requested.

B. Claims 27-32 Are Patentable Over the Five-Part Combination of Jones + Walker + Richards + Bankersonline.com + Nabe

Claims 27-32 stand rejected under 35 U.S.C. § 103 as rendered obvious by the 4-part combination of:

- (1) Jones (US Pub. No. 2004/0117300), in view of
- (2) Walker (US Pub. No. 2008/0052225), further in view of
- (3) Richards, B., “Beware the Arrival of Unsolicited Debit Cards” (Madison Capital Times: 2000), further in view of
- (4) Bankersonline.com, Commentary; Supplement I to Part 205 - Official Staff Interpretations: Jan 31,2002, www.bankersonline.com/regs/205/regecomm.txt at pages 1-35, and further in view of
- (5) Nabe (US Patent No. 7,305,364).

Office Action at 16. Applicant respectfully submits that these references, whether considered individually or in combination, do not render the claimed invention obvious.

1. If the Six-Part Combination is Deficient, Surely the Five-Part Subcombination is Deficient

Claims 27-32 recite some of the same features as those in Claims 1 and 17 used to distinguish the 6-part combination of Melchione + Walker + Richards + Bankersonline.com +

Jones + Nabe. If the 6-part combination is deficient, then surely the 5-part subcombination of Jones + Walker + Richards + Bankersonline.com + Nabe is deficient.

Claims 27-32 are patentable over the 5-part subcombination for at least the same reasons set forth above in Section III.A for Claim 17.

2. Claims 27-32 are Patentable over the Five-Part Combination

Claims 27-32 stand rejected as allegedly rendered obvious by Jones in view of Walker, further in view of Richards, further in view of Bankersonline.com, and further in view of Nabe. Office Action at 16. Applicant respectfully traverses this rejection of the claims as amended.

Claim 27 recites “determining . . . if the customer is an existing bank deposit account holder with the bank”. The Office Action contends this limitation is disclosed in Jones at Fig. 5A, step 206. Office Action at 17. Figure 5A is a “flow chart[] for activating dual cards”, which are dual-account cards having a private label credit card [PLCC] and a general-use credit card. Jones at [0020]. Step 206 is a decision block for activating a dual card that asks whether the activating customer is an “Existing Dual Card Customer or New Customer”. Figure 5A, step 206. An existing customer in Jones means an existing credit card customer, not an existing “bank deposit account holder”, as claimed.

Jones was distinguished above in Section III.A.2 for not teaching or suggesting an ““unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.” Claim 27 recites a similar feature and is distinguishable over Jones for the same reasons as before.

The Examiner does admit that Jones fails to teach that element, but asserts that Walker supplies this feature. Office Action at 17-18. However, Walker’s unsolicited credit card does

not teach or fairly suggest distribution of unsolicited deposit account cards, as discussed in detail above in Section III.A.2 for Claim 1.

The Office Action acknowledges that Walker is directed to unsolicited credit cards, not unsolicited deposit account cards. Office Action 18. The Examiner points to Richards to cure this deficiency of Walker. However, Richards does not teach or suggest an unsolicited debit card associated with an inactive bank deposit account. On the contrary, the debit card in Richards was associated with a preexisting active deposit account. Richards is very distinguishable for the reasons set forth in Section III.A.2 and, in fact, affirmatively teaches away from the claimed invention. Likewise, Bankersonline.com is distinguishable for the same reasons set forth above in Section III.A.2.

Nabe's system for marketing auto loans to an inactive customer base is distinguishable for the reasons set forth above for Claim 1 in Section III.A.2.

Dependent Claims 28-32 are patentable for at least the same reasons as Claim 27.

2. Claims 33-36

Claims 33 – 36 stand rejected as allegedly rendered obvious by Jones + Walker + Richards + Bankersonline.com+ Nabe and further in view of Strock. Office Action at 20-21. Applicant respectfully traverses this rejection.

For the reasons noted above, Claims 33-36 are patentable for at least the same reasons as independent Claim 27. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of these claims.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Dated: August 31, 2011

Respectfully submitted,

Electronic signature: //Stephen T. Schreiner//
Stephen T. Schreiner
Registration No.: 43,097
GOODWIN PROCTER LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 346-4000
Attorney for Applicant